The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JEFFREY S. MAILLOUX,
KEVIN J. RYAN,
TODD A. MERRITT
and
BRETT L. WILLIAMS

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Appeal No. 2004-1705
Application 08/984,701

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HEARD: February 8, 2005

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Before THOMAS, BARRY and LEVY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 40-43, 45, 59, 60, 62-87. At pages 2 and 4 of the answer, the examiner withdrew the rejection of claims 64, 67, 68, 73-75

and 83-85 under 35 U.S.C. § 102(a), and the separate rejection of all claims on appeal under 35 U.S.C. § 103. Only the rejection of claims 40-43, 45, 59, 60, 62, 63, 65, 66, 69-72, 76-82, 86 and 87 remain for our consideration.

Representative claim 43 is reproduced below:

43. A memory module comprising:

a plurality of memories of which at least one of said memories includes a mode select pin for switching as between a burst mode and a pipelined mode of operation.

The following reference relied on by the examiner is:

| | | |
|---|---|---|
| Manning | 5,610,864 | Mar. 11, 1997<br>(filing date Feb. 10, 1995) |

Claims 40-43, 45, 59, 60, 62, 63, 65, 66, 69-72, 76-82, 86 and 87 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Manning.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the answer for the examiner's positions.

## OPINION

We reverse.

Each of independent claims 40, 43, 59, 60, 63, 65, 66, 69, 77, 81 and 86 variously recite in some manner a mode select pin for switching between a burst mode and a pipelined mode of operation.

Our study of Manning leads us to agree with appellants' assessment of this reference generally set forth at pages 5-8 of the principal brief on appeal. The examiner's position primarily relies upon Manning's Figure 1 as well as portions of columns 5-7. Column 5, lines 43-46 merely indicates that pipelined architectures exist as other types of memory architectures that may be applicable to the current disclosure in Manning, yet no details are supplied in any other portion of the reference to suggest the specific applicability of the burst mode operability of Manning's memory to a pipelined architecture, specifically as to how it would be implemented. The teachings at column 5, lines 43-62, in context, merely appear to teach the conceptual applicability (the possibility in appellants' words) of burst mode architectures to pipelined architectures but not presenting any

further circuits in the remaining parts of the specification of Manning applicable to pipelined architectures.

Various modes are taught at column 6, lines 14-34 and column 7, lines 29-54 as relied upon by the examiner. The various modes, however, do not teach any switchability between a burst mode and a pipelined mode of operation as required by each of the claims on appeal. We therefore agree with appellants' observation at page 8 of the principal brief on appeal that "Col. 5, lines 41-50 discusses the possibility of using a pipelined architecture, but not as enabling switching between pipeline or burst operations within the same memory, as disclosed and claimed by the Appellants."

In order for us to sustain the examiner's rejection over prior art, we would need to resort to speculation or unfounded assumptions to supply deficiencies in the factual basis of the rejections. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). This we decline to do.

Our reviewing court has made it clear in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), and In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), that rejections must be supported by substantial evidence in the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. As indicated in Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34, the examiner's positions must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record."

The examiner's responsive arguments portion of the answer beginning at the fourth page merely repeats the initial reliance in the statement of the rejection on certain portions of columns 5-7 of Manning. As indicated earlier, these portions of Manning clearly fall short of indicating to us the anticipatory nature of the subject matter of the claims on appeal at least as applied to pipelined memory schemes. Plainly, Manning does not explain and certainly does not show in Figure 1 of his patent switching circuitry to switch between a pipelined mode addressing

scheme and a burst mode addressing scheme, which is the essential argument provided in the brief and reply brief by appellants. More specifically, Manning does not further develop the general statement of applicability at column 5, lines 43-46 of his invention being usable with pipelined architectures such as to explain how a plurality of memory-type operations may occur in an overlapping manner or processed simultaneously in a manner consistent in the art and recognized to be necessary for a pipelined memory accessing scheme.

Therefore, Manning alone, within 35 U.S.C. § 102(a), without additional evidence, cannot be fairly said to anticipate the subject matter of each independent claim on appeal. As such, the rejection of the respective dependent claims must be reversed as well.

In view of the foregoing, the decision of the examiner rejecting all claims on appeal under 35 U.S.C. 102 is reversed.

REVERSED

James D. Thomas
Administrative Patent Judge )

Lance Leonard Barry
Administrative Patent Judge ) BOARD OF PATENT APPEALS AND INTERFERENCES

Stuart S. Levy
Administrative Patent Judge )

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SCHWEGMAN, LUNDBERG,
WOESSNER & KLUTH, P.A.
P. O. Box 2938
Minneapolis, MN 55402